

REMARKS

Applicant has studied the Office Action dated December 27, 2007. Claims 1-6 and 8-14 are pending. Claims 1, 6, 8, and 11 have been amended and claim 7 has been canceled without prejudice. New claims 13 and 14 have been added. Claims 1 and 6 are independent claims. No new matter has been added as the amendments and new claims have support in the specification as originally filed. Further, it is believed that no new issue is raised by the present amendments to the claims.

It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Amendments to the Claims

Claims 1, 6, 8, and 11 have been amended to more clearly disclose the invention. It is respectfully submitted that the amendments have support in the application as originally filed.

§ 102 Rejections

Claims 1, 5-7, and 11-12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Srinivasan et al. ("Srinivasan" US 20010023436). Applicant respectfully disagrees with the Examiner's interpretation of Srinivasan and respectfully traverses the rejection.

It is respectfully noted that a proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1991).

With this paper, claim 7 has been canceled without prejudice. It is, therefore, respectfully submitted that the rejection is moot with respect to claim 7 and it is respectfully requested that the rejection be withdrawn. Nonetheless, canceled claim 7 is

discussed below because the features of claim 7 have been incorporated into independent claims 1 and 6.

With regard to the rejection of claim 7, it is respectfully noted that the Examiner asserts that Srinivasan discloses an editing method, wherein the extracting step of the thumbnail image is performed while the broadcasting stream is stored, as recited in claim 7, because the cited portion discloses “stored files manipulated according to edit,” citing paragraph 0175.

However, it is unclear to Applicant as to how the asserted disclosure of “stored files manipulated according to edit” in Srinivasan is relevant to extracting the thumbnail image of the broadcasting stream while the broadcasting stream is stored, recited in independent claims 1 and 6, as amended. Moreover, contrary to the Examiner’s assertion, Applicant’s review of the cited portion of Srinivasan reveals that Srinivasan fails to disclose or suggest extracting the thumbnail image of the broadcasting stream while the broadcasting stream is stored, as recited in amended independent claims 1 and 6. It is respectfully noted that paragraph 0175 of Srinivasan is directed to “sorting” and “manipulating” thumbnails as opposed to extracting thumbnails.

Therefore, it is respectfully asserted that independent claims 1 and 6 are allowable over the cited reference. It is further respectfully asserted that claims 2 and 5, which depend from claim 1, and claims 11-12, which depend from claim 6, also are allowable over the cited reference.

§ 103 Rejections

Claim 2-4 and 8-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Srinivasan in view of Drucker et al. (“Drucker” U.S. Pat. No. 7,251,790). This rejection is respectfully traversed.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the

burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

As asserted above, independent claims 1 and 6 are allowable over Srinivasan. Moreover, it is respectfully submitted that Drucker fails to cure the deficiencies of Srinivasan with respect to extracting the thumbnail image of the broadcasting stream while the broadcasting stream is stored, as recited in amended independent claims 1 and 6.

Therefore, it is respectfully asserted that independent claims 1 and 6 are allowable over the cited combination of references. It is further respectfully asserted that claims 2-4 and 8-10, which depend from claims 1 and 6, respectively, are also allowable over the cited combination of references.

New Claims

With this paper, new claims 13 and 14 have been added. It is respectfully submitted that the new claims have support in the application as originally filed. Support for claims 13 and 14 can be found, for example, at paragraph 0039 of the specification.

It is respectfully asserted that claims 13 and 14, which depend from claims 1 and 6, respectively, are allowable over the cited references by virtue of both the features recited therein and their dependence from the respective allowable base claims.

CONCLUSION

In view of the above remarks, Applicant submits that claims 1-6 and 8-14 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as originally filed, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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